

REMARKS

Claims 1, 7, 8, 18-20, 30-32, 54, 63, and 72 have been amended, and new claims 87-89 have been added. Claims 73-75 have been cancelled without prejudice or disclaimer of subject matter. Therefore, claims 1-68, 71, 72, and 76-89 are pending in this application, with claims 1, 54, 63, and 72 being independent. No new matter has been added.

In the non-final Office Action of October 20, 2008 ("Office Action"), claims 1-32, 35-43, 47-68, and 71-86 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,880,731 ("Liles") and W.I.P.O. Patent Application Publication No. 01/84461 ("Kim"); claims 33 and 34 were rejected under 35 U.S.C. § 103(a) based on Liles, Kim, and U.S. Patent No. 7,007,065 ("Matsuda"); claims 44-46 were rejected under 35 U.S.C. § 103(a) based on Liles, Kim, and U.S. Patent No. 7,177,811 ("Ostermann"). The Applicant submits that these rejections should be withdrawn for at least the following reasons.

Section 103 rejection based on Liles and Kim

Liles and Kim do not support a conclusion of obviousness with respect to claims 1-32, 35-43, 47-68, and 71-86.

Independent claim 1 recites, among other things, a method comprising:

receiving, independently of the first user and the message, out-of-band information indicating a context of the first user; and

communicating, independently of the first user and the second user, the out-of-band information to the second user by changing an animation of the avatar representing the first user to graphically convey the context of the first user indicated by the received out-of-band information

(emphasis added). Liles and Kim, whether taken alone or in combination, fail to disclose or suggest at least these features.

Liles discloses a system for communication between participants using graphical representations in a chat session where the participants may select a "gesture" with which to animate the participant's avatar. See Liles, col. 10, lines 33-45. As the Office Action acknowledges on page 3, however, it is the participant that proactively selects an emotion with which to animate his/her avatar. Therefore, Liles does not describe or suggest communicating,

independently of the first user and the second user, the out-of-band information to the second user by changing an animation of the avatar representing the first user, as recited in claim 1.

Recognizing the deficiencies in Liles, the Office Action turns to Kim. Kim discloses a method for changing the screen image in a three-dimensional virtual space based on the determined physical location of a user. *See* Kim, Abstract. In particular, Kim describes an image management unit 1024 that retrieves a predetermined screen image representing a 3D virtual space, based on the determined physical location. *See* Kim, p. 5, lines 29-33. In other words, Kim describes that the 3D virtual space in which the user's avatar operates is changed, but there is no suggestion that the avatar itself is changed in any way. *See id.*; p. 5, lines 6-8. Therefore, Kim does not describe or suggest communicating, independently of the first user and the second user, the out-of-band information to the second user by changing an animation of the avatar representing the first user, as recited in claim 1.

In summation, the Office Action only relies upon Kim for the reception of out-of-band information and relies upon Liles for the communication of the out-of-band information. Such a combination, if permissible, fails to describe or suggest communicating out-of-band information independently of the first user and the second user, as recited in claim 1, because Liles requires the proactive selection of an animation of the avatar by a user. *See, e.g.*, Liles, FIG. 9; col. 10, lines 33-45.

For at least the foregoing reasons, Liles and Kim—taken alone or in a proper combination—fail to disclose or suggest each and every element recited in independent claim 1. Moreover, no basis has been established for concluding that it would have been obvious to one of ordinary skill in the art to bridge the aforementioned gaps between the claims and the applied references. *See* M.P.E.P. § 2141 (III), 8th Ed., Rev. 6 (July 2008). Indeed, the applied references do not provide such a basis. The section 103 rejection of claim 1 should accordingly be withdrawn.

Though directed to different statutory classes, independent claims 54, 63, and 72 recite features similar to those discussed above with regard to claim 1, and are, therefore, distinguishable over the applied references for at least similar reasons. Likewise, the other rejected claims in the application are each dependent on these independent claims and are

allowable over the applied references for at least the same reasons. Therefore, withdrawal of the section 103 rejections is requested.

Section 103 rejection based on Liles, Kim, and Matsuda

In the Office Action, claims 33 and 34 were rejected under section 103 based on Kim, Liles, and Matsuda. Claims 33 and 34 depend upon independent claim 1. As discussed above, Kim and Liles fail to disclose or suggest each and every feature of independent claim 1. Matsuda, which was applied to certain features of claims 33 and 34, fails to cure the deficiencies of Kim and Liles with respect to independent claim 1. Furthermore, no basis has been established for concluding that it would have been obvious to one of ordinary skill in the art to bridge the aforementioned gaps between the claims and the applied references. *See* M.P.E.P. § 2141 (III). Accordingly, Kim, Liles and Matsuda—whether taken alone or in a proper combination—fail to render obvious claim 1 or its dependent claims 33 and 34. The section 103 rejection and the timely allowance of dependent claims 33 and 34 is therefore requested.

Section 103 rejection based on Liles, Kim, and Ostermann

The Office Action rejected claims 44-46 under section 103 based on Kim, Liles, and Ostermann. Claims 44-46 ultimately depend upon claim 1. As discussed above, Kim and Liles fail to disclose or suggest each and every feature of independent claim 1. Ostermann, which was applied to certain features of claims 44-46, fails to cure the deficiencies of Kim and Liles with respect to the independent claim. Further, no basis has been established for concluding that it would have been obvious to one of ordinary skill in the art to bridge the aforementioned gaps between the claims and the applied references. *See* M.P.E.P. § 2141 (III). Accordingly, Kim, Liles and Matsuda—whether taken alone or in a proper combination—fail to render obvious claim 1 or its dependent claims 44-46. The section 103 rejection of claims 44-46 should therefore be withdrawn, and claims 44-46 should accordingly be allowed.

New Claim 87-89

New claims 87-89 ultimately depend upon independent claim 1. For at least the reasons discussed above, Liles, Kim, Matsuda, and Ostermann fail to disclose or suggest each and every

feature of independent claim 1. These references likewise fail to anticipate or render obvious the new dependent claims 87-89, which require all of the features recited in base claim 1. The applied reference further fail to disclose or suggest at least some of the features recited in the new dependent claims. New claims 87-89 should therefore be allowed over the applied references.

Conclusion

It is requested that the Examiner reconsider the application in view of the remarks and timely allow the pending claims.

It is believed that all pending issues in the outstanding Office Action have been addressed by this paper. The Office Action, however, contains a number of statements reflecting characterizations of the related art and the claims. Whether or not any such statement is identified herein does not constitute an automatic subscription to any statement or characterization in the Office Action. In addition, there may be reasons for patentability of any or all pending or other claims that have not been expressed above.

If there are any questions regarding this paper or the application generally, a telephone call to the undersigned would be appreciated since this may expedite prosecution of the application.

It is hereby petitioned that the period for response to the Office Action be extended for one (1) month. The Petition for Extension of Time fee of \$130.00 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please grant any additional extensions of time required to enter this paper and apply any required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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